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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/300,302	04/27/1999	GERARDO HIDALGO LLINAS	B-3645.61707	4291

7590 05/20/2003

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EXAMINER

PASTERCZYK, JAMES W

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/300,302

Applicant(s)
Hidalgo Llinas et al.

Examiner
J. Pasterczyk

Art Unit
1755



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/5/03 and 2/28/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above, claim(s) 9 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 11, and 13-24 is/are rejected.
- 7) ☒ Claim(s) 5, 11, 15-17, and 22 is/are objected to.
- 8) ☒ Claims 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 33 6) ☐ Other:

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1. This Office action is in response to the amendments filed 2/5/03 and the IDS filed 2/28/03 and refers to the Office action mailed 2/5/03, which ultimately refers to the Office action mailed 11/17/00.

2. Claims 5, 11, 15-17 and 22 are objected to because of the following informalities: in claims 15-17, there are still numerous instances where "cyclo" is misspelled as well as "methylene" and "cyclopentadienyl" as noted in the immediately previous Office action. In claims 5 and 22, insert --an-- before "alumoxane" and --a-- before "trialkylaluminum". Further in claim 22, "trialkylaluminum" is misspelled. Appropriate correction is required.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, since the R^{III} group already has a hydroxy group bonded to it in claim 1 and is defined therein as being divalent, having monovalent groups being R^{III} with a hydroxy already bonded to them is inconsistent.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-4, 6, 7, 10, 11, 13-16, 18, 19 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vega as cited in and for the reasons of record given in paragraph 9 of the Office action of 11/17/00.

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6. Claims 1-8, 10, 11 and 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidalgo Llinas as cited in and for the reasons of record given in paragraph 10 of the Office action of 11/17/00.

7. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canich as cited in and for the reasons of record given in paragraph 11 of the Office action of 11/17/00.

8. Applicant's arguments filed 2/5/03 have been fully considered but they are not persuasive.

As applicants know, a reference is not limited to its preferred embodiments, hence that the prior art used here does not disclose the hydroxylated versions of the compounds as being preferred is of no moment. Furthermore, since the Vega and Hidalgo Llinas references are from the same assignee as the present application with common inventors, applicants had a chance to claim their now preferred embodiment upon the first disclosure of it to the public, but apparently chose not to, and what is not claimed is dedicated to the public.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is (703) 308-3497. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone number for the organization where

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this application or proceeding is assigned is (703) 872-9310 for normal faxes, 872-9311 for after final faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700



J. Pasterczyk

5/19/03